

SUPPORT FOR THE AMENDMENTS

The present amendment cancels claims 1-17, and adds new claims 18-45.

Support for newly added claims 18 and 38 is found at specification page 3, lines 28-38, page 4, lines 1-25, page 5, lines 9-27, as well as original claims 1, 15 and 16.

Support for newly added claim 19 is found at specification page 3, lines 33-36, page 11, lines 33-38, page 12, lines 1-38, page 13, lines 1-3, as well as original claims 1, 3 and 4.

Support for newly added claim 20 is found at specification page 13, lines 5-28, as well as original claims 5 and 6.

Support for newly added claims 21-24 is found at specification page 9, lines 12-38, page 10, lines 1-15 and 32-38, page 11, lines 1-18, as well as original claims 7-10.

Support for newly added claims 25-27 and 39-41 is found at specification page 5, lines 34-38, page 6, lines 1-7 and 19-25, as well as original claims 1 and 2

Support for newly added claim 28 is found at specification page 8, lines 20-24.

Support for newly added claim 29 is found at specification page 7, lines 21-29, as well as original claim 11.

Support for newly added claim 30 is found at specification page 7, lines 31-34, as well as original claim 12.

Support for newly added claim 31 is found at specification page 5, lines 25-27.

Support for newly added claims 32 and 33 is found at specification page 11, lines 23-31, as well as original claim 14.

Support for newly added claims 34-36 and 42-44 is found at specification page 13, lines 30-36, page 16, lines 8-10, page 17, lines 30-32, page 19, lines 26-28, page 21, lines 14-16.

Support for newly added claims 37 and 45 is found at specification page 1, lines 7-13, page 14, lines 23-29, as well as original claim 17.

It is believed that these amendments have not resulted in the introduction of new matter.

REMARKS

Claims 18-45 are currently pending in the present application. Claims 1-17 have been cancelled, and new claims 18-45 have been added, by the present amendment.

The rejection of now cancelled claims 15-17 under 35 U.S.C. § 103(a) as being obvious over McConnell (U.S. Patent 6,235,924) is respectfully traversed with respect to new claims 18-45.

Claim 18 is drawn to a composition produced by the process recited therein, wherein the composition comprises a benzoate mixture of isononyl benzoate and one or more benzoic esters whose alkoxy groups have from 7 to 13 carbon atoms, wherein the benzoate mixture has a tin(II) concentration of less than 1 mg/kg (ppm). Claim 38 recites a composition comprising a benzoate mixture of isononyl benzoate and one or more benzoic esters whose alkoxy groups have from 7 to 13 carbon atoms, wherein the benzoate mixture has a tin(II) concentration of less than 1 mg/kg (ppm).

McConnell describes a multi-step esterification reaction method for preparing benzoates derived from benzoic acid, at least one alcohol selected from the group consisting of monohydric alcohols having from 6 to 12 carbon atoms and dihydric alcohols having from 2 to 8 carbon atoms, and a catalyst selected from organic titanium catalysts as particularly preferred catalysts, and stannate catalysts, which are tetravalent tin catalysts (i.e., Sn(IV)) (See e.g., abstract, column 2, lines 27-67, column 3, lines 1-65, column 4, lines 4-6 and 59-67, and claims 1-3). Examples of monohydric alcohols described in McConnell include hexanols, octanols (e.g., 2-ethylhexanol), decanols and dodecanols (See e.g., column 4, lines 44-48, column 5, lines 29-30, column 8, lines 23-28 and 34, column 9, lines 18 and 66, and claims 6 and 7). Examples of dihydric alcohols described in McConnell include ethylene glycol, propylene glycol, 1,4-butanediol, and 1,6-hexanediol (See e.g., column 4, lines 49-52).

McConnell fails to provide sufficient motivation and guidance to direct a skilled artisan to particularly select the claimed *isononyl alcohol* from either the tremendously broad genus of alcohols, which include not only monohydric alcohols having from 6 to 12 carbon atoms, but also dihydric alcohols having from 2 to 8 carbon atoms, or the preferred embodiment of 2-ethylhexanol, described and claimed in McConnell. McConnell describes utilizing organic titanium catalysts as particularly preferred catalysts. While McConnell also describes utilizing stannate catalysts, which are *tetravalent* tin catalysts (i.e., Sn(IV)), McConnell fails to disclose or suggest utilizing the claimed *divalent* tin catalyst (i.e., Sn(II)). Furthermore, as acknowledged in the Official Action (See e.g., page 4, line 15), McConnell is silent with respect to the claimed limitation of the benzoate mixture having a tin(II) concentration of less than 1 ppm. Since the aforementioned deficiencies in the disclosure of McConnell can not be overcome by mere presumption or conjecture, a *prima facie* case of obviousness has not been met.

Assuming *arguendo* that sufficient motivation and guidance is considered to have been provided by McConnell to direct a skilled artisan to particularly select not only the claimed isononyl alcohol from either the tremendously broad genus of monohydric and dihydric alcohols or the preferred embodiment of 2-ethylhexanol, but also the claimed tin(II) catalyst from either the tin(IV) catalyst or the preferred titanium catalysts, described and claimed therein, such a case of obviousness is rebutted by a showing of the unexpected advantage of obtaining the benzoate mixture having a tin(II) concentration of less than 1 ppm, as described and evidenced in the present specification (See e.g., page 3, lines 28-38, page 4, lines 1-3 and 27-31 and 35-36, page 16, line 14, page 21, lines 19-20), without having to conduct the inconvenient, time consuming, and costly multi-step esterification reaction method described in McConnell.

Withdrawal of this ground of rejection is respectfully requested.

The provisional rejection of now cancelled claim 15 on the ground of obviousness-type double patenting as being unpatentable over: (1) claim 1 of copending application 10/418,103 (U.S. 2004/0015007) (Grass '007); (2) claim 1 of copending application 10/570,199 (U.S. 2007/0010599) (Grass '559); and (3) claim 22 and 23 copending application 11/739,345 (Grass '345), is respectfully traversed with respect to new claims 18-45.

The benzoate mixture of the present invention, which is obtained without base treatment as claimed in claim 18, has a tin(II) concentration of less than 1 ppm, as claimed in claims 18 and 38.

In contrast, the benzoate mixture of Grass '007 is obtained by saponification, which involves treatment with a base. The benzoate mixture of Grass '559 is also obtained with base treatment (See e.g., [0061], [0070]). Moreover, Grass '007, Grass '559, and Grass '345 fail to describe that the benzoate mixture has a tin(II) concentration of less than 1 ppm, as presently claimed.


As previously discussed, since the deficiencies in the disclosures of Grass '007, Grass '559, and Grass '345 can not be overcome by mere presumption or conjecture, a *prima facie* case of obviousness has not been met.

Withdrawal of these grounds of rejection is respectfully requested.

In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



David P. Stitzel
Attorney of Record
Registration No. 44,360

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)